

50. (Twice amended) The emulsion according to claim 49, wherein said at least one filler is chosen from talc, mica, silica, kaolin, tetrafluoroethylene fluorocarbon polymers, fluorinated ethylene-propylene resins, starch, natural mother-of-pearl, boron nitride, microspheres, microsponges, polyethylene powders, nylon powders, microbeads of silicone resin and silica microspheres.

REMARKS

I. Status of the Claims

Claims 1-60 and 62-67 are now pending in this application. Claim 21 has been amended to correct an inadvertent typographical error. Claim 50 has been amended to further clarify the scope of the invention in light of the Examiner's suggestions. No new matter has been introduced by this amendment, as will be discussed further below.

Further, Applicants accept the Examiner's statement, "Applicant's arguments with respect to claims 1-66 have been considered but are moot in view of the new ground(s) of rejection," to mean that the rejections recited in the previous Office Action have been overcome and that only the rejections contained in the present Office Action remain. (1/17/01 Office Action, page 7, lines 10-11.)

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II. Rejections Under 35 U.S.C. § 112

In the present Office Action, at pages 2-3, claims 1-11, 38, 50, 53, and 54 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants traverse these rejections for the reasons outlined below.

Claims 1-11

The Examiner has rejected claims 1-11 because, in her view, "the specification does not provide a standard for ascertaining the requisite degree" of the terms "reducing," "eliminating," and "improving." (1/17/01 Office Action, page 2.) Further, the Examiner questions "[r]elative to what is the transfer, migration or staying powder [sic] of the composition being changed?" (1/17/01 Office Action, page 3.) Applicants submit that these points made by the Examiner are addressed clearly and sufficiently in Applicants' specification, especially in Applicants' examples.

Terms of degree such as "reducing," "eliminating," and "improving" may be recited in claim language, even if such terms are imprecise, without automatically rendering the claim indefinite. M.P.E.P. § 2173.05 (b). The statutory requirement of definiteness is satisfied if "one of ordinary skill in the art would understand what is claimed, in light of the specification." M.P.E.P. § 2173.05 (b). The test to be employed by the Examiner is to determine (1) whether the specification discloses a standard for measuring the degree, and (2) if there is no standard, whether one skilled in the art

would be reasonably apprised of the scope of the invention. M.P.E.P. § 2173.05 (b).

This test has been met by Applicants' disclosure.

In particular, Applicants submit that there is a standard in the specification for measuring the Applicants' terms of degree. For example, transfer, as indicated in the specification, is the result of the following phenomenon: "the composition, once applied, is liable to be deposited, at least partly, on certain supports with which it is placed in contact." (Specification, page 2, lines 10-11.) Transfer of a composition of the present invention is measured comparatively with transfer of a composition with a similar viscosity that does not comprise the specific silicone, otherwise comprised in Applicants' invention. This is demonstrated by Applicants' examples, wherein two compositions having similar viscosities are compared—Emulsion A, comprising an α,ω -oxyalkylenated silicone of the invention, and Emulsion B, comprising thickeners and an oxyalkylenated silicone not of the invention. (Specification, page 22, lines 1-10.)

For example, the transfer resistance of two such comparative compositions is collated in a table. (Specification, page 26, lines 7-16.) Although only transfer is explicitly measured, migration and staying power, which are similar observational-type characteristics, can be measured in a similar fashion. It is clear from the table that the amount of transfer observed is objectively measured by using a grading system, and then the scores are averaged (0 = no transfer, 1=traces, 2 = trace +, 3 = slight, 4 = slight +, etc.). For example, as indicated by the table, a composition with a score of 3.8 has "reduced" transfer over a similar composition with a score of 5. Thus, it is clear that

a standard is provided and that the terms of degree of a composition of the invention are measured relative to a composition not comprising the silicone, as claimed by Applicants. Accordingly, Applicants respectfully request that the rejection of claims 1-11 be withdrawn.

Claim 38

The Examiner has rejected claim 38 as "indefinite because it recites the units $R_3SiO_{1/2}$, $R_2SiO_{2/2}$, $RSiO_{3/2}$ but does not define 'R'." (1/17/01 Office Action, page 3, lines 3-4.) Applicants traverse this rejection for the following reason. The definition of "R" is recited in claim 12 and claim 38 depends from claim 12. Because dependent claims include all of the limitations of the claim from which such claims depend, and because claim 38 is in proper dependent-claim format, it follows that claim 38 includes the definition of "R" that is recited in claim 12. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 50, 53, and 54

The Examiner has rejected claims 50, 53, and 54 as "indefinite because of the term 'Nylon'." (1/17/01 Office Action, page 3, lines 5-8.) Further, the Examiner reasons that "it is unclear if [Nylon] represents a tradename." (1/17/01 Office Action, page 3, line 6.) Applicants traverse this rejection, but, to facilitate prosecution, claim 50 has

been amended in accordance with the Examiner's suggestion to recite "nylon," instead of "Nylon." Thus, Applicants respectfully request that this rejection be withdrawn.

III. Rejection Under 35 U.S.C. § 102(b)

Process Claims

The Examiner's rejection of claims 1, 2, 10, and 11 under 35 U.S.C. § 102(b) as anticipated by EP 0 374 332 ("EP '332"), or alternatively by EP 0 331 833 ("EP '833"), has been maintained for the reasons set forth on pages 4-5 of the present Office Action. Additionally, claims 1-14, 23, 25, 27-30, 32, 34-37, 39, 40, 42-50, 56-60, and 62-66 have been rejected as anticipated by EP 0 819 426 A2 ("EP '426") for the reasons set forth on pages 3-4 of the present Office Action.¹ Applicants respectfully traverse.

The Examiner alleges that claims 1, 2, 10, and 11 "are not limited to the silicones of the formulas instantly claimed ... are not limited to the instantly claimed viscosity ... and are not limited by any quantitative amount of silicone." (1/17/01 Office Action, page

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Applicants obtained an English-language translation of EP 0 819 426 A2 in order to respond to the Examiner's rejections over the foreign-language counterpart, which was previously submitted by Applicants in an Information Disclosure Statement. For consideration by the Examiner, Applicants have submitted this English-language translation in a Supplemental Information Disclosure Statement filed concurrently with this response.

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5, lines 1-8.) It is Applicants' position, however, that claims 1, 2, 10, and 11 are limited by a quantitative amount of silicone, and this limitation by itself is sufficient to overcome EP '332 and EP '833 as anticipatory references. Similarly, these claims and additionally process claim 66 are patentable over EP '426 as well.

In order for an anticipation rejection to be proper, "each and every element as set forth in the claim" must be expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To anticipate the present claims successfully, a reference must show "the identical invention" "in as complete detail as is contained in the ... claim[s]." *Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). EP '332, EP '833, and EP '426 fail to disclose every element of claims 1 and 2, let alone "in as complete detail."

Claims 1, 2, and 66 are process claims in this application. Each recites "at least one α,ω -substituted oxyalkylenated silicone" in an "amount effective" for specific purposes, *i.e.*, respectively reducing or eliminating transfer or migration, improving staying power, and non-therapeutic treatment. To anticipate, EP '332, EP '833, and/or EP '426, individually, must disclose each of these separate and distinct elements. However, EP '332, EP '833, and EP '426 are silent as to the reduction or elimination of transfer or migration, the improvement of staying power, and non-therapeutic treatment. Additionally, each reference is silent as to "effective" amounts of an α,ω -substituted oxyalkylenated silicone. Further, each reference fails to disclose, unlike Applicants, that

a silicone in such an "effective" amount would be responsible for these functions, *i.e.*, reducing or eliminating transfer or migration, improving staying power, or non-therapeutic treatment. Because EP '332, EP '833, and EP '426 do not teach these elements of the present claims, not one of the references anticipates.

The Examiner also contends that claims 1, 2, 10, and 11 are not limited by any quantitative amount of silicone. (1/17/01 Office Action, page 5, line 8.) The Examiner is incorrect. Claims 10 and 11 are limited by express numerical ranges for the α,ω -substituted oxyalkylenated silicone in the composition. Claim 10 recites that the "silicone is present in the composition in a proportion ranging from 0.1 to 30%, by weight relative to the total weight of the composition." And claim 11 recites that the "silicone is present in the composition in a proportion ranging from 0.5 to 10%." Likewise, claims 1 and 2 recite that the silicone is present "in an amount effective for...." Proper use of the term "effective amount" in claims is discussed in the M.P.E.P. under the heading, "Numerical Ranges and Amounts Limitations." M.P.E.P. § 2173.05(c)(III). Although this particular discussion in the M.P.E.P. concerns patentability with respect to the statutory requirements of 35 U.S.C. § 112, second paragraph, Applicants submit that because the term "effective amount" is discussed under this particular heading, it must be considered, at the very least, a viable and proper amount limitation. Therefore, contrary to the Examiner's assertion, the term "effective amount" does describe a quantitative amount of silicone.

Accordingly, as this quantitative limitation is not taught in EP '332, EP '833, or EP '426, it cannot be said that all of the elements of the present claims are taught by the cited references. Accordingly, Applicants respectfully request that these rejections be withdrawn.

Composition Claims

The Examiner has rejected claim 12 and some of its dependent claims as anticipated by EP 0 819 426 A2 ("EP '426") for the reasons set forth on pages 3-4 of the present Office Action. Applicants respectfully traverse.

The composition claims, particularly claim 12, are not anticipated by EP '426 because EP '426 does not disclose the claimed silicone in combination with the specific components listed in claim 12, nor does it include the specific viscosity limitation as claimed. The Examiner provides "[f]or viscosity, see page 3, lines 30-32." (1/17/01 Office Action, page 4, lines 7-8.) However, the passage that the Examiner has pointed to refers back to the structure directly above the passage. The structure above the passage shows polyetherpolysiloxanes with one alkoxy group in a lateral position, whereas, among other differences, the present invention has two alkoxy groups, one at each of the terminal positions of the structure. Clearly, these two structures are not the same. Further, the specific viscosity that is recited in the passage cited by the Examiner is not the viscosity of the polyetherpolysiloxane. Rather, it is the viscosity of the silicone oils in which such polyetherpolysiloxanes are preferably dispersed because

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such polyetherpolysiloxanes have extremely high viscosities. (See EP '426, page 3, lines 30-32.) EP '426 thus does not teach each and every claim element of the composition claims.

Accordingly, as EP '426 is silent as to viscosity measurements, and therefore does not teach each and every claim element of the rejected claims, EP '426 cannot anticipate the present claims under § 102(b), and the rejection should be withdrawn.

IV. Rejection Under 35 U.S.C. § 103(a)

The Examiner has rejected, under 35 U.S.C. § 103(a), claims 1-19, 23-60, and 62-67 as unpatentable over EP '426 in combination with EP '833 and claims 1-12, 25, 27-37, 39-60, and 62-66 as unpatentable over EP '426 in combination with U.S. Patent No. 5,593,680 ("US '680"). Applicants respectfully traverse these rejections.

Three elements are required to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference (or references when combined) must teach or suggest all the prior art limitations. See M.P.E.P. § 2143. Neither combination of references, EP '426 with EP '833 nor EP '426 with US '680, satisfies any of these three requirements.

EP '426 in combination with EP '833

As discussed above with respect to the anticipation rejections, neither EP '426 nor EP '833 teaches or suggests all of the limitations of the claims of the present invention. Specifically, as amended, claim 12 recites an emulsion with a specific measurable viscosity. These references, in contrast, do not teach or even remotely suggest this specific viscosity limitation and, therefore, are inadequate to render the present composition claims obvious.

With respect to the broad process claims, claims 1, 2, and 66, use of the silicones for the purposes of reducing or eliminating transfer or migration, improving staying power, or providing non-therapeutic treatment is neither taught nor suggested in either EP '426 or EP '833. To the contrary, EP '833 is directed toward use of the silicones for stabilizing the emulsion. (See, e.g., page 3, line 54 - page 4, line 4). And EP '426 is directed toward use of the silicones as emulsifiers in antiperspirant formulations. Simply put, EP '426 and EP '833 do not teach or suggest all of the limitations of the present claims.

Additionally, EP '833 requires a water-swellaable clay, a solid, as a component. There would have been no motivation for one of ordinary skill in the art to modify EP '833 to omit this required component simply to obtain the presently claimed invention. This is yet another reason why EP '833 cannot and does not render the present claims obvious. Accordingly, the Applicants respectfully request that this rejection be withdrawn.

EP '426 in combination with US '680

The Examiner has rejected claims 1-12, 25, 27-37, 39-60, and 62-66 under 35 U.S.C. § 103(a) as unpatentable over EP '426 in combination with U.S. Patent No. 5,593,680 ("US '680"). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness with more than one reference, the Examiner is required to provide some objective reason to combine the teachings of the references. See M.P.E.P. § 2143.01 (citing *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)). Further, the Examiner must present a convincing line of reasoning supporting the rejection. *Ex Parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985).

There is no motivation to combine EP '426 with US '680. EP '426 and its deficiencies have been discussed at length above, and US '680 does not remedy such deficiencies. US '680 is directed to microsphere-containing compositions that are free of fats, e.g., oils. Similarly, EP '426 provides that an advantage of its compositions is that they can be used in formulations free of silicone oils. (See, EP '426, page 4, lines 20-21.) In contrast, the compositions of the present invention do not require microspheres and do require fats, specifically silicones (oils, waxes, etc.). Accordingly, the motivation to combine US '680 with the silicone-containing compositions of EP '426 in order to obtain the presently claimed invention is non-existent. Further, there would

have been no reasonable expectation of success in making such a combination.

Finally, US '680 recites compositions that are in the form of gels, not emulsions, as required by the present claims. Thus, as the Examiner has not cured the deficiencies of the primary reference, this rejection relying on the secondary reference US '680 must fail for lack of support.

Accordingly, the Applicants respectfully request that this rejection be withdrawn, as no *prima facie* case of obviousness has been established.

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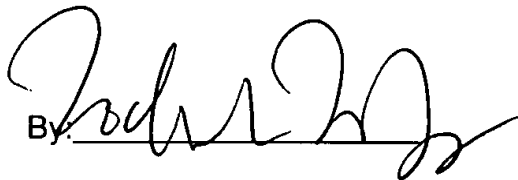
V. Conclusion

In view of the foregoing remarks, the Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 13, 2001

Enclosure: Marked-up version of claims and specification under 37 C.F.R. § 1.121

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Marked-up version of claims and specification under 37 C.F.R. § 1.121

Below, Applicants provide a marked-up version of the specification and claims that are affected by Applicants' present Amendment. Applicants use the ~~strike-out~~ function to indicate deleted material and the **bold** function to indicate added material.

IN THE CLAIMS:

21. (Twice amended) The emulsion according to claim 20, wherein said at least one dye is present in the emulsions in a proportion ranging from greater than 0 to 15%, by weight relative to the total weight of the emulsion.

50. (Twice amended) The emulsion according to claim 49, wherein said at least one filler is chosen from talc, mica, silica, kaolin, tetrafluoroethylene fluorocarbon polymers, fluorinated ethylene-propylene resins, starch, natural mother-of-pearl, boron nitride, microspheres, microsponges, polyethylene powders, ~~Nylon~~ **nylon** powders, microbeads of silicone resin and silica microspheres.

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